

Atty. Dkt. No. 072827-2002

Remarks

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 is currently being amended.

Claims 33-40 are being added.

After amending the claims as set forth above, claims 1-40 are now pending in this application.

The rejection under 35 U.S.C. 112, second paragraph, is believed to be inapplicable to the present claims and reconsideration is respectfully requested.

The abstract by Fisher are excluded from the present claims by the second proviso, which excludes thiophene at R₁.

The Examiner rejects claims 1-6 under 35 U.S.C. 103(a) as allegedly being obvious over the cited Chemical Abstracts. The Examiner asserts one would be motivated to prepare the present compounds from the genus of the references with the reasonable expectation of obtaining additional useful compounds. This rejection is respectfully traversed.

With regard to Fisher et al., and the Cohnen references, Fisher et al. disclose their compounds as useful as animal growth promoters and feed efficiency enhancers. Cohnen et al. disclose their compounds as useful for treating hypertonia, angina pectoris, and coronary insufficiency.

The compounds disclosed by Fisher, Cohnen, Howe, and Weber all contain two carbons between the amino nitrogen and the asserted "R₁" substituent, while the claimed compounds contain at least 3 carbons. The person of ordinary skill would not be motivated to insert one or more carbons into the molecular backbone disclosed corresponding to the R₁ side of the claimed compounds, since this two-carbon attribute is common to all active compounds disclosed by each

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reference. Modifying the backbone would be likely to destroy the activity that makes the compounds useful in the first place, and therefore these references do not provide a motivation to select the presently claimed compounds.

The above arguments are equally applicable to Schromm, Kumar, Schlager, and Ferris, all of whom disclose compounds with activities, where all compounds contain a molecular backbone comprising two carbons on the dimethyl side.

Knolle, McClure, and Haynes disclose a pyridyl group corresponding to the "R₁" position, which has been excluded from the present claims by the second proviso. Haynes also discloses a phenyl substitution in the chain. No motivation is provided to delete the phenyl group from the chain.

Thus, none of the compounds disclosed would lead the person of ordinary skill in the art to manufacture the presently claimed compounds because such modifications of the disclosed art would require changes to the molecules that would be expected to change its chemistry and likely result in a loss of activity, and provide benefits that are entirely speculative. Such an obviousness determination could only be based on a hindsight reconstruction of the invention using Applicant's own disclosure as a blueprint, which is not permitted. MPEP 2143.01.

Furthermore, in order to establish a prima facie case of obviousness, it is necessary that the prior art teach or suggest every limitation of the claims. MPEP 2142, *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Each of the claims recites the limitation of activity in the calcium receptor inhibitor assay, having an $IC_{50} \leq 10 \mu M$. Yet this limitation is not disclosed by any prior art reference. Therefore, for this reason as well, no prima facie case of obviousness has been established.

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Closing

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date Jan. 9, 2004By Richard San Pietro

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